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| HEWLETT PACKARD COMPANY              |             |                      | EXAMINER            |                  |
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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|                              |                          |                  |
|------------------------------|--------------------------|------------------|
| <b>Office Action Summary</b> | Application No.          | Applicant(s)     |
|                              | 10/718,179               | TALLEY ET AL.    |
|                              | Examiner<br>CHAN S. PARK | Art Unit<br>2625 |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

1) Responsive to communication(s) filed on 13 November 2007.  
 2a) This action is FINAL.                    2b) This action is non-final.  
 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935.C.D. 11, 453 O.G. 213.

#### Disposition of Claims

4) Claim(s) 1-4,6-19,23 and 24 is/are pending in the application.  
 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
 5) Claim(s) \_\_\_\_\_ is/are allowed.  
 6) Claim(s) 1-4,6,7,9-19,23 and 24 is/are rejected.  
 7) Claim(s) 8 is/are objected to.  
 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

9) The specification is objected to by the Examiner.  
 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
     Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
     Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
 a) All    b) Some \* c) None of:  
 1. Certified copies of the priority documents have been received.  
 2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

1) Notice of References Cited (PTO-892)  
 2) Notice of Draftsperson's Patent Drawing Review Request (PTO-448)  
 3) Information Disclosure Statement(s) (PTO/SB/08)  
     Paper No(s)/Mail Date \_\_\_\_\_

**DOUGLAS Q. TRAN**  
PRIMARY EXAMINER

4) Interview Summary (PTO-413)  
     Paper No(s)/Mail Date. \_\_\_\_\_.  
 5) Notice of Informal Patent Application  
 6) Other: \_\_\_\_\_

## DETAILED ACTION

### *Response to Amendment*

1. Applicant's amendment was received on 11/13/07, and has been entered and made of record. Currently, **claims 1-4, 6-19, 23 and 24** are pending.

### *Response to Arguments*

2. Applicant's arguments with respect to **claims 1-4, 6-19, 23 and 24** have been considered but are moot in view of the new ground(s) of rejection.

### *Claim Objections*

3. Claims are objected to because of the following informalities:

Claim 1, line 11, "the at least one electronic edit instruction" should be -- the at least one electronic edit instruction data --;  
Appropriate correction is required.

### *Claim Rejections - 35 USC § 112*

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4. Claim 11 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one

skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

**The MPEP at 2173.05(i) states:**

"The mere absence of a positive recitation is not basis for an exclusion. Any claim containing a negative limitation which does not have basis in the original disclosure should be rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. Note that a lack of literal basis in the specification for a negative limitation may not be sufficient to establish a *prima facie* case for lack of descriptive support. *Ex parte Parks*, 30 USPQ2d 1234, 1236 (Bd. Pat. App. & Inter. 1993)."

Examiner does not find any support for the negative limitation, "without regard to position information on the printed document", claimed in claim 13 in the Specification.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 11 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

5. Claim recites the limitation "without regard to position information on the printed document". It is unclear as what this position information is referring to. Is it referring to the position information of the multifunction printer, the printed paper, or something else? Clarification/explanation from the Specification is respectfully requested.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1, 10-14, 16-18, 23 and 24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kikinis U.S. Patent No. 5,870,624 in view of Frank U.S. Patent No. 3,611,291.

6. With respect to claim 1, Kikinis teaches a method of editing a printed page, comprising:

automatically scanning (scanning a document using the platen and roller assembly in col. 3, lines 50-65 & col. 4, lines 31-34), via a multifunction printer (figs. 1 & 2), the printed page, wherein the printed page includes text (text document in col. 11, lines 11-13);

electronically obtaining, via the multifunction printer, a first page description file (unedited ASCII-based file in col. 11, lines 13-15. Note that the ASCII-based file is construed as PCL, which is one of page description files, according to U.S. Patent No. 7,068,387 (col. 4, lines 1-2)), which corresponds to at least text on the printed page (col. 11, lines 13-15);

electronically modifying, via the multifunction printer, the first page description file using at least one electronic edit instruction to create a second page description file that

includes the text modified according to the instruction (user editing the file to create a edited ASCII based file (the second page description file) in col. 11, lines 17-20).

Kikinis, however, does not explicitly teach that the printed page includes at least one handwritten edit symbol, wherein the page is edited based on the handwritten edit symbol.

Frank, the same field of endeavor of editing the printed page (figs. 2 & 9), teaches a method of editing a printed page, comprising:

scanning the printed page, wherein the printed page includes at least one handwritten edit symbol (col. 5, lines 56-70 & fig. 2);

electronically identifying from the scanned printed page at least one electronic edit symbol, which corresponds to the at least one handwritten edit symbol (col. 2, lines 50-71 & col. 4, lines 37-75); and

electronically modifying the scanned data using the at least one electronic edit instruction to create a edited data that includes the text modified according to the at least one handwritten edit symbol (printing the edited data according to col. 4, lines 6-13 & lines 37-75).

At the time of the invention, it would have been obvious to one of ordinary skill in the art to modify the multifunction printer of Kinkinis to incorporate the function of document editing using the handwritten symbols of Frank.

The suggestion/motivation for doing so would have been to provide automatic document editing system just by feeding the printed page with the handwritten instruction to the multifunction printer.

Therefore, it would have been obvious to combine Kikinis with Frank to obtain the invention as specified in claim 1.

7. With respect to claim 10, the combination of Kikinis and Frank teaches the method of claim 1, wherein electronically identify the at least one electronic edit symbol via the multifunction printer comprises:

optically recognizing the at least one handwritten edit symbol as the at least one electronic edit symbol from an array of electronic edit symbols stored in a memory of the multifunction printer (memory for storing the symbol and its function shown in col. 3, lines 15-37 of Frank); and

wherein electronically and automatically modifying the first page description file via the multifunction printer comprises:

retrieving the at least one electronic edit instruction from the edit symbol array and applying, at the multifunction printer, the at least one electronic edit instruction to the first page description file (col. 2, lines 50-71 & col. 4, lines 37-75 of Frank).

8. With respect to claim 23, the combination of Kikinis and Frank teaches the method of claim 1, wherein electronically and automatically modifying the first page description file comprises using the multifunction printer exclusively, independent of and separate from a computer, to electronically modify the first page description file (col. 2, lines 50-71 & col. 4, lines 37-75 of Frank). Also, note that the multifunction printer of Kikinis does not involve any secondary computers. Hence, the multifunction printer of Kikinis is independent of and separate from a computer.

9. With respect to claim 11, arguments analogous to those presented for claim 1, are applicable. Also, note that the multifunction printer of Kikinis does not involve any secondary computers. Hence, the multifunction printer of Kikinis is independent of and separate from a computer.

10. With respect to claim 12, the combination teaches the method of claim 11, comprising printing the second electronic printable file (col. 4, lines 11-13 of Frank & col. 11, lines 23-26. Note that both references teaches method of printing the edited document at a printer).

11. With respect to claim 24, the combination teaches the method of claim 11, wherein the first electronic file comprises a first page description file and wherein the second electronic printable file comprises a second page description file (edited & unedited ASCII-based files in col. 11, lines 13-15. Note that the ASCII-based file is construed as PCL, which is one of page description files, according to U.S. Patent No. 7,068,387 (col. 4, lines 1-2)).

12. With respect to claim 13, Kikinis discloses a multifunction device comprising:  
a memory (a memory/buffer for storing pixel-based file in col. 11, lines 12-16);  
a scanner configured for obtaining an electronic image file (pixel-based file) of at least one printed page that includes a text for storing the electronic image file in the memory (col. 11, lines 12-16);  
an optical recognition function configured to perform an optical character recognition on the electronic image file to obtain an first page description file (unedited

ASCII-based file) corresponding to the text of the at least one printed page (col. 11, lines 12-20);

an edit manager stored in the memory and configured, in communication with the optical recognition function, to apply an electronic edit instruction corresponding to the electronic edit instruction to the first page description file to create a second page description file (edited ASCII-based file) that includes the text modified according to the at least one instruction (col. 11, lines 12-20), wherein the edit manager implements the electronic edit instruction at the multifunction printer independent of, and separate from, a computer (Again, the multifunction printer of Kikinis does not involve any secondary computers. Hence, the multifunction printer of Kikinis is independent of and separate from a computer.)

Frank, the same field of endeavor of editing the printed page (figs. 2 & 9), discloses an editing device for editing a printed page, comprising:

means for scanning the printed page, wherein the printed page includes at least one handwritten edit symbol (col. 5, lines 56-70 & fig. 2);

means for electronically identifying from the scanned printed page at least one electronic edit symbol, which corresponds to the at least one handwritten edit symbol (col. 2, lines 50-71 & col. 4, lines 37-75); and

means for electronically modifying the scanned data using the at least one electronic edit instruction to create a edited data that includes the text modified according to the at least one handwritten edit symbol (printing the edited data according to col. 4, lines 6-13 & lines 37-75).

At the time of the invention, it would have been obvious to one of ordinary skill in the art to modify the multifunction printer of Kinkinis to incorporate the function of document editing using the handwritten symbols of Frank.

The suggestion/motivation for doing so would have been to provide automatic document editing system just by feeding the printed page with the handwritten instruction to the multifunction printer.

Therefore, it would have been obvious to combine Kikinis with Frank to obtain the invention as specified in claim 13.

13. With respect to claim 14, the combination discloses the multifunction printer of claim 13 wherein the optical character recognition function configured to optically recognize: the text of the at least one printed page from the electronic image file as the first page description file (creating the ASCII-based file in col. 11, lines 14-15).

14. With respect to claim 16, the combination discloses the multifunction printer of claim 13 wherein the edit manager comprises:

an edit symbol array including:

a plurality of electronic edit symbols, including the at least one electronic edit symbol, with each electronic edit symbol uniquely corresponding to a handwritten edit symbol (col. 3, lines 14-37 of Frank); and

a plurality of electronic edit instructions with each electronic edit symbol corresponding uniquely to one of the electronic edit instructions (col. 4, lines 31-75 of Frank).

15. With respect to claim 17, the combination teaches the multifunction printer of claim 16 wherein the edit manager comprises:

an edit rules library configured to support application of the electronic editing instructions of the edit symbol array and including at least one of a grammar function, a dictionary function, and a format function (changing the format to Vogue Bold with a 20-point and 11-pica line in col. 4, lines 12-13 of Frank).

16. With respect to claim 18, the combination discloses the multifunction printer of claim 13 wherein the optical character recognition function is stored in at least one of the memory of the multifunction printer, a controller of the multifunction printer, and an application specific integrated circuit (col. 5, lines 56-70 of Frank & col. 11, lines 12-25 of Kikinis).

Claims 2-4 are rejected under 35 U.S.C. 103(a) as being unpatentable over the combination of Kikinis and Frank as applied to claim 1 above, and further in view of Ericson et al. U.S. Patent Application Publication No. 2002/0054778 (hereinafter Ericson).

17. With respect to claim 2, the combination teaches the method of claim 1 but it does not explicitly teach that electronically and automatically modifying the first page description file comprises using a computer in communication with, and cooperation with, the multifunction printer to electronically modify the first page description file.

Ericson, the same field of endeavor of editing the document using the handwritten edit symbols (fig. 5), teaches the method of scanning the document with the

symbols at one location and modifying/editing the document at a remote computer (paragraph 83, lines 6-8).

At the time of the invention, it would have been obvious to one of ordinary skill in the art to modify the system of Kikinis and Frank to have the document edited at a remote computer.

The suggestion/motivation for doing so would have been to reduce the cost at the scanning device by having the editing processor at the remote computer.

Therefore, it would have been obvious to combine three references to obtain the invention as specified in claim 1.

18. With respect to claim 3, the combination teaches the method of claim 2 and further comprising:

performing, via at least one of the multifunction printer and the computer, printing the second page description file to at least one of the multifunction printer and a second printer (col. 4, lines 11-13 of Frank & col. 11, lines 23-26. Note that both references teaches method of printing the edited document at a printer).

19. With respect to claim 4, the combination teaches the method of claim 2 wherein electronically obtaining the first page description file comprises:

obtaining a digital image file of the printed page (pixel-based file in col. 11, line 15 of Kikinis) by scanning the printed page with a scanner of the multifunction printer and optically recognizing the digital image file, via at least one of the multifunction printer and the computer, for conversion to the first page description file (translating/converting the file into the ASCII-based file in col. 11, lines 11-17 of Kikinis).

Claims 6 and 9 are rejected under 35 U.S.C. 103(a) as being unpatentable over the combination of Kikinis, Frank and Ericson as applied to claims 1 and 2 above, and further in view of Yano et al. U.S. Patent No. 6,910,184 (hereinafter Yano).

20. With respect to claim 6, the combination teaches the method of claim 2 (particularly, refer to fig. 3 of Frank), but it does not explicitly teach the method of optically recognizing, via the multifunction printer, an electronic identifier of the printed page as an electronic memory pointer and, based on the electronic memory pointer, retrieving the first electronic printable file from a memory available at a uniform resource locator address.

Yano, the same field of endeavor of optically recognizing printed information via multifunction printer art, teaches the method of optically recognizing, via the multifunction printer, an electronic identifier of the printed page as an electronic memory pointer and, based on the electronic memory pointer, retrieving the first electronic printable file from a memory available at a uniform resource locator address (col. 7, lines 38-64 & col. 8, lines 21-60).

At the time of the invention, it would have been obvious to one of ordinary skill in the art to implement the method of retrieving a desired document via a network into the combined editing/printing system of Kikinis, Frank and Ericson.

The suggestion/motivation for doing so would have been to retrieve the network documents for editing and printing using the method taught by Kikinis, Frank and Ericson.

Therefore, it would have been obvious to combine four references to obtain the invention as specified in claim 6.

21. With respect to claim 9, arguments analogous to those presented for claim 6, are applicable. However, Yano does not explicitly teach whether the retrieval of the file is done wirelessly. Examiner take an Official Notice that the wireless communication in the network printer embedded in PC of Kikinis is well known in the network art. Therefore, it would have been obvious to one of ordinary skill in the art to implement the wireless communication function in the combined system of three references.

Claim 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over the combination of Kikinis and Frank as applied to claim 1 above, and further in view of Yano.

22. With respect to claim 7, arguments analogous to those presented for claim 6, are applicable. Refer to col. 7, lines 38-64 of Yano for retrieving document using the electronic identifier.

Claim 15 is rejected under 35 U.S.C. 103(a) as being unpatentable over the combination of Kikinis and Frank as applied to claim 13 above, and further in view of Kanematu U.S. Patent No. 7,130,066 (hereinafter Kanematu).

23. With respect to claim 15, the combination discloses the multifunction printer of claim 13, wherein Kikinis further discloses a user interface comprising a save function (fig. 9).

The combination, however, does not explicitly disclose a user interface comprising: an electronic mail function, a print function, and a send function.

Kanematu, the same field of endeavor of the multifunction printer art, discloses a multifunction printer comprising a user interface comprising:

an electronic mail function configured to permit specifying an electronic mail address to which an electronic printable file will be digitally sent by the multifunction printer (figs. 25 & 53);

a print function configured to permit specifying that the electronic printable file be printed by the multifunction printer (figs. 14~18);

a save function configured to permit specifying that the electronic printable file be saved in the memory of the multifunction printer (figs. 23 (button 363) & 63); and

a send function configured to permit sending the electronic printable file in a memory location external of the multifunction printer (fig. 23).

At the time of the invention, it would have been obvious to one of ordinary skill in the art to implement the user interface of Kanematu into the combined system of Kikinis and Frank.

The suggestion/motivation for doing so would have been to provide a plurality of options for managing the second electronic printable file over the network.

Therefore, it would have been obvious to combine three references to obtain the invention as specified in claim 15.

Claim 19 is rejected under 35 U.S.C. 103(a) as being unpatentable over the combination of Kikinis and Frank as applied to claim 13 above, and further in view of Minami et al. U.S. Patent Application Pub. No. 2004/0141200 (hereinafter Minami).

24. With respect to claim 19, the combination discloses the multifunction printer of claim 13 but it does not disclose a wireless transceiver configured for communication with a wireless transponder tag of the at least one printed page with the wireless transponder tag being configured as a memory pointer that identifies a memory location storing the first page description file.

Minami, the same field of endeavor of the multifunction printer, discloses the printer (fig. 1) having a wireless transceiver configured for communication with a wireless transponder tag of the at least one printed page with the wireless transponder tag being configured as a memory pointer that identifies a memory location storing the first page description file (paragraphs 74 & 75).

At the time of the invention, it would have been obvious to one of ordinary skill in the art to modify the printer of Kikinis to include a wireless transceiver configured for communication with a wireless transponder tag of the at least one printed page with the wireless transponder tag being configured as a memory pointer that identifies a memory location storing the first page description file as taught by Minami.

The suggestion/motivation for doing so would have been to facilitate the file searching method by implementing the IC tag into the printed page.

Therefore, it would have been obvious to combine three references to obtain the invention as specified in claim 19.

***Allowable Subject Matter***

25. Claim 8 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

***Conclusion***

26. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

27. Any inquiry concerning this communication or earlier communications from the examiner should be directed to CHAN S. PARK whose telephone number is (571) 272-7409. The examiner can normally be reached on M-F 8am-4:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Moore can be reached on (571) 272-7437. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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DOUGLAS Q. TRAN  
PRIMARY EXAMINER

*Tran*

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csp  
January 8, 2008